
RESPONSE

The examiner states in the Office Action Summary that claims numbered 1-48, 53-66 and 69-73 are pending in the application, and claims numbered 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 54 and 63-66, and 69 are rejected. Claims numbered 5-8, 12-15, 23, 25, 29-31, 35-37, 53, 55-57, 60, 62 and 70-73.

(1) The examiner has made this first office action after an RCE as final, stating that “All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR § 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR § 1.114.” Applicants respectfully disagree.

First, all the claims are not drawn to the same invention claimed in the application prior to entry of the submission under 37 CFR § 1.114. The previously filed amendment, dated April 28, 2008, was entered upon the acceptance of the request for continued examination. This amendment changed the claims. As such, all claims are not currently drawn to the same invention as was claimed prior to the entry of the submission under 37 CFR § 1.114.

Second, all claims could not be finally rejected on the grounds of record, as the grounds of record were withdrawn and a new rejection was issued in the instant office action.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of the finality of the current office action.

(2) The examiner has rejected claims numbered 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 63-66 and 69 under 35 U.S.C. § 103(a) as obvious over Sauerberg et al. (WO 01/79150) in view of Pershadsingh et al. (US 6,028,088) and De la Brouse-Elwood et al. (US 6,200,995).

The Examiner takes the position that the Y substituent in Sauerberg corresponds to T-Z-U of the instant compound of formula (I). Applicants respectfully disagree.

As was discussed in the previous response, the Z group in the instant case is a

divalent group formed from a polycyclic ring system containing from two to 4 aryl or heteroaryl ring systems joined by single bonds. An example of such a group, as shown in Example 13, is biphenyl.

The Y group of Sauerberg may be alkylaralkyl. The definition of aryl from Sauerberg gives examples of aryl groups being “phenyl, naphthyl, (1-naphthyl or 2-naphthyl) and the like.” The Examiner relies on the phrase “and the like” to broaden the definition of aryl beyond that of what one or ordinary skill in the art would consider in the definition of aryl, as defined by Sauerberg.

The Examiner relies on two secondary references in an attempt to show that aryl could mean biphenyl. Applicants respectfully submit that each of these secondary references actually favor Applicants’ reading of the instant case, wherein “aryl” of Sauerberg does not cover two aryl groups joined by a single bond.

The first reference is that of Pershadsingh et al. (US 6,028,088). The Examiner states that Pershadsingh defines aryl to mean biphenyl. This is actually incorrect. Aryl is defined, in Pershadsingh, as groups such as “phenyl, naphthyl, and the like, which may be substituted with one or more functional groups … such as …aryl … to form groups such as biphenyl....” Therefore, it would appear from the definition in Pershadsingh that aryl does not include biphenyl and, to get to biphenyl, the aryl group of Pershadsingh must be substituted with another aryl group. Pershadsingh actually **teaches away from** the Examiner’s reading of what aryl should encompass. As a matter of fact, Pershadsingh also includes the words “and the like”, but, nonetheless, still finds it necessary to include an optional aryl substituent on the base aryl group in order to arrive at biphenyl. This supports Applicants’ finding that aryl in Sauerberg does not include groups such as biphenyl.

The Examiner’s second secondary reference is that of De la Brouse-Elwood et al. (US 6,200,995, hereinafter, Elwood). Elwood defines aryl as aromatic rings that may be fused together or linked covalently. Elwood, like Pershadsingh above, actually helps Applicants’ position, as Elwood found it necessary to specifically describe aryl as including rings linked covalently in the definition. Applicants submit that, without such specific definition, the term aryl would not include groups such as biphenyl.

Applicants take the position that if one of ordinary skill in the art wanted the term aryl to include the situation of one or more aromatic rings connected through a single bond, such a distinction should be specifically described in the definition of aryl. Both Pershadsingh and Elwood support this conclusion, as both references wanted aryl to include, for example, biphenyl, and both did so specifically.

Applicant respectfully requests reconsideration and withdrawal of the rejection to claims numbered 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 63-66 and 69 under 35 U.S.C. § 103(a).

The examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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